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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,369	11/12/2003	John Kaewell	I-2-0118.1US	6823

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VOLPE AND KOENIG, P.C.
DEPT. ICC
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

EXAMINER

BOLOURCHI, NADER

ART UNIT	PAPER NUMBER
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2611

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/706,369	Applicant(s) KAEWELL, JOHN	
	Examiner Nader Bolourchi	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/23/2004 and 6/1/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Information Disclosure Statement

2. The information disclosure statements (IDS) submitted on 2/23/2004 and 6/1/2004 have been considered and made of record by the examiner.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1 and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of prior U.S. Patent No. 6,704,380. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of prior U.S. Patent No. 6,704,380 contain(s) every element of claim(s) 1 and 5 of the instant application and as such anticipate(s) claim(s) 1 and 5 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

5. Claim 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,704,380 in view of claim 6.

Regarding claim 7, claim 1 of U.S. Patent No. 6,704,380 discloses the steps of providing a stable high frequency reference signal; dividing said high frequency reference signal to provide a system clock signal having a plurality of system clock phases; and adjustably selecting a system clock phase of said plurality of system clock

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phases in accordance with the PN signal in order to provide said synchronized system clock signal. However, claim 1 of U.S. Patent No. 6,704,380 does not disclose the means for these steps.

Claim 6, does disclose the means for receiving, dividing and adjusting of a clock signal. Therefore, It would have been obvious to one of ordinary skill in the art, at the time the invention was made to use the teaching of claim 1 and claim 6 of U.S. Patent No. 6,704,380 to generate the claimed invention with a reasonable expectation of success.

6.

7. Although the conflicting claims are not identical, they are not patentably distinct from each other because limitations recited in claim 7, which are using the phrase "means for" are corresponding to the steps in claim 1 of the aforesaid patent.

8. Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,704,380 in view of Hendrickson et al. (US 6,002,710).

Regarding claim 2, claim 1 of U.S. Patent No. 6,704,380 discloses the steps of providing a stable high frequency reference signal; dividing said high frequency reference signal to provide a system clock signal having a plurality of system clock phases; and adjustably selecting a system clock phase of said plurality of system clock phases in accordance with the PN signal in order to provide said synchronized system

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clock signal. However, claim 1 of U.S. Patent No. 6,704,380 does not disclose phase adjustment of PN clock.

Hendrickson et al. disclose phase adjustment of PN clock (col. 24: lines 56-60). Therefore, It would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the teaching of claim 1 of U.S. Patent No. 6,704,380 and Hendrickson et al. in order to allow phase differences between PN clock in the receiver and a PN clock in a remote transmitter synchronization of a as suggested by Hendrickson et al. (Abstract).

9. Claim 3 and 4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,704,380 in view of Hendrickson et al. (US 6,002,710).

Regarding claim 3, claim 1 of U.S. Patent No. 6,704,380 discloses the steps of providing a stable high frequency reference signal; dividing said high frequency reference signal to provide a system clock signal having a plurality of system clock phases; and adjustably selecting a system clock phase of said plurality of system clock phases in accordance with the PN signal in order to provide said synchronized system clock signal. However, claim 1 of U.S. Patent No. 6,704,380 does not disclose tracking control signal.

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Hendrickson et al. disclose tracking control signal (Slow tracking in Abstract). Therefore, It would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the teaching of claim 1 of U.S. Patent No. 6,704,380 and Hendrickson et al. in order to allow phase differences between PN clock in the receiver and a PN clock in a remote transmitter synchronization of a as suggested by Hendrickson et al. (Abstract).

Regarding claim 4, claim 1 of U.S. Patent No. 6,704,380 discloses the steps of providing a stable high frequency reference signal; dividing said high frequency reference signal to provide a system clock signal having a plurality of system clock phases; and adjustably selecting a system clock phase of said plurality of system clock phases in accordance with the PN signal in order to provide said synchronized system clock signal. However, claim 1 of U.S. Patent No. 6,704,380 does not disclose PN clock phase adjustment

Hendrickson et al. disclose tracking control signal (Slow tracking in Abstract), which include PN clock phase adjustment (last 4 lines of Abstract). Therefore, It would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the teaching of claim 1 of U.S. Patent No. 6,704,380 and Hendrickson et al. in order to allow phase differences between PN clock in the receiver and a PN clock in a remote transmitter synchronization of a as suggested by Hendrickson et al. (Abstract).

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10. Claim 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,704,380 in view of Hendrickson et al. (US 6,002,710). Hendrickson et al. disclose high frequency oscillator (RF oscillator 104 in col. 8: line 13; Examiner notes that the use of temperature compensated crystal oscillator is well known in the art). Therefore, It would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the teaching of claim 1 of U.S. Patent No. 6,704,380 and Hendrickson et al. in order to allow phase differences between PN clock in the receiver and a PN clock in a remote transmitter synchronization of a as suggested by Hendrickson et al. (Abstract).

Remarks

3. No claim is allowed.

Contact Information


4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nader Bolourchi whose telephone number is (571) 272-8064. The examiner can normally be reached on M-F 8:30 to 4:30.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David. C. Payne can be reached on (571) 272-3024. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Nader Bolourchi
2/12/2007
Art Unit 2611


JEAN B. CORRIELLUS
PRIMARY EXAMINER
2-15-07